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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/236,552	01/26/1999	WATARU TOMIDA	102654	1322

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EXAMINER

POKRZYWA, JOSEPH R

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 12/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/236,552

Applicant(s)

TOMIDA, WATARU

Examiner

Joseph R. Pokrzywa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 14-16,18,19,21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-16,18,19,21 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/30/02 has been entered.

### ***Response to Amendment***

2. Applicant's amendment was received on 10/30/02, and has been entered and made of record. Currently, **claims 14-16, 18, 19, 21, and 22** are pending.

### ***Drawings***

3. The corrected or substitute drawings were received on 10/30/02. These drawings are acceptable.

### ***Claim Objections***

4. **Claim 18** is objected to because of the following informalities:

In **claim 18**, lines 1 and 2, "claim 17" should read "claim 14".

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 14-16, 18, 19, 21, and 22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Owens *et al.* (U.S. Patent Number 6,023,700) in view of Finney *et al.* (U.S. Patent Number 6,182,118).

Regarding **claim 14**, Owens discloses an internet facsimile device (electronic mail service 10, column 4, lines 5 through 40) comprising means for receiving by the internet facsimile device via an internet at least one set of electronic mail data (column 4, lines 21 through 65, and column 5, lines 37 through 66) attached with an electronic mail title (see Fig. 3, column 6, lines 19 through 44), means for reading the electronic mail title (column 47 through column 6, line 44), means for displaying the electronic mail title that has been received along with the electronic mail data (column 3, lines 38 through 48), means for selecting electronic mail data from the at least one set of electronic mail data based on the electronic mail title (column 5, line 47 through column 6, line 44), and means for forming an image based on electronic mail data selected by the data selecting means (column 5, lines 19 through 36), wherein the internet facsimile device displays the received electronic mail title (see Fig. 3, column 6, lines 19 through 57, and column 7, lines 1 through 40).

However Owens fails to specifically teach of means for determining whether or not each one of the at least one set of electronic mail data has a high priority based on a corresponding

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electronic mail title, and subsequently having the image forming means forms an image based on the electronic mail data which has been determined to have a high priority. Finney discloses a device (electronic mail server, seen in Fig. 1) comprising means for receiving at least one set of electronic mail data (column 3, lines 10 through 37, and column 4, lines 9 through 27) attached with an electronic mail title (column 3, line 43 through column 4, line 27), means for reading the electronic mail title (column 4, lines 13 through 21, and column 3, lines 43 through 61), means for determining whether or not each one of the at least one set of electronic mail data has a high priority based on a corresponding electronic mail title (steps 14 and 18 in Fig. 4, column 9 through 21), and means for forming an image based on electronic mail data (column 3, lines 10 through 37, and column 4, lines 15 through 65), wherein the image forming means forms an image based on the electronic mail data which has been determined to have a high priority (column 3, lines 45 through 67, see steps 20 and 22 in Fig. 4, column 4, lines 9 through 27). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Finney's teachings in the system of Owens. Owens system would easily be modified to include Finney's teachings, as the systems share cumulative features, being additive in nature.

Regarding **claim 15**, Owens and Finney disclose the device discussed above in claim 14, and Owens further teaches of including a second receiving means for receiving facsimile data via a public network (column 5, lines 34 through 36, and column 7, lines 1 through 40), and data converting means for converting the at least one set of the electronic mail data into facsimile data (see abstract, column 4, line 53 through column 5, line 36, and column 7, lines 1 through 17), wherein the image forming means forms an image based on the facsimile data received via the

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public network and on the facsimile data converted from the at least one set of the electronic mail data (column 5, lines 34 through 36, and column 7, lines 1 through 40).

Regarding *claim 16*, Owens and Finney disclose the device discussed above in claim 14, and Finney further teaches of means for determining whether or not each one of the at least one set of electronic mail data has a high priority based on a corresponding electronic mail title (steps 14 and 18 in Fig. 4, column 9 through 21), and means for notifying the user of electronic mail data having the high priority (step 22 in Fig. 4, column 1, line 38 through column 2, line 34, and column 3, line 48 through column 4, line 27). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Finney's teachings in the system of Owens. Owens system would easily be modified to include Finney's teachings, as the systems share cumulative features, being additive in nature.

Regarding *claim 18*, Owens and Finney disclose the device discussed above in claim 14, and Finney further teaches of means for notifying a user when the image forming means forms an image based on the electronic mail data which has been determined to have a high priority (step 22 in Fig. 4, column 1, line 38 through column 2, line 34, and column 3, line 48 through column 4, line 27). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Finney's teachings in the system of Owens. Owens system would easily be modified to include Finney's teachings, as the systems share cumulative features, being additive in nature.

Regarding *claim 19*, Owens and Finney disclose the device discussed above in claim 14, and Finney further teaches that the priority determining means determines that a priority is high

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when corresponding electronic mail title contains a predetermined character (column 48 through 67, see step 16 in Fig. 3).

Regarding *claim 21*, Owens discloses a method of controlling an internet facsimile device (electronic mail service 10, column 4, lines 5 through 40) comprising the steps of receiving electronic mail attached with a header (see Fig. 3, column 6, lines 19 through 44) by the internet facsimile device from a remote internet facsimile device (column 4, lines 21 through 65, and column 5, lines 37 through 66), with the header including a title (see Fig. 3), reading the title from the header (column 47 through column 6, line 44), displaying the title that has been received along with the electronic mail data (column 3, lines 38 through 48), determining whether or not the electronic mail has a priority based on a corresponding electronic mail title (column 5, line 37 through column 6, line 18), and forming an image based on electronic mail data which has been determined to have a priority (column 5, lines 19 through column 6, line 18), wherein the internet facsimile device displays the received electronic mail title (see Fig. 3, column 6, lines 19 through 57, and column 7, lines 1 through 40).

However, Owens fails to specifically teach of determining whether or not the electronic mail has a *high priority* based on a corresponding electronic mail title, and subsequently forming an image based on electronic mail data that has been determined to have a *high priority*. Finney discloses a method for controlling a device (electronic mail server, seen in Fig. 1) comprising the steps of receiving electronic mail data (column 3, lines 10 through 37, and column 4, lines 9 through 27) attached with a header by the device (column 1, lines 15 through 59, and column 3, lines 10 through 37, being inherent in an e-mail message), with the header including a title (column 3, line 43 through column 4, line 27), reading the title (column 4, lines 13 through 21,

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and column 3, lines 43 through 61), determining whether or not the electronic mail has a high priority based on a corresponding electronic mail title (steps 14 and 18 in Fig. 4, column 9 through 21), and forming an image based on the electronic mail which has been determined to have a high priority (column 3, lines 45 through 67, see steps 20 and 22 in Fig. 4, column 4, lines 9 through 27). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Finney's teachings in the system of Owens. Owens system would easily be modified to include Finney's teachings, as the systems share cumulative features, being additive in nature.

Regarding *claim 22*, Owens and Finney disclose the method discussed above in claim 21, and Finney further teaches of determining whether or not the electronic mail belongs to a predetermined group based on the title (steps 14 and 18 in Fig. 4, column 9 through 21), and notifying a user of an urgent mail when the electronic mail belongs to the predetermined group (step 22 in Fig. 4, column 1, line 38 through column 2, line 34, and column 3, line 48 through column 4, line 27). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Finney's teachings in the system of Owens. Owens system would easily be modified to include Finney's teachings, as the systems share cumulative features, being additive in nature.



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***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

J. R. P.

Joseph R. Pokrzywa  
Examiner  
Art Unit 2622

jrj  
December 14, 2002

Anh Vinh Nguyen

**MADELEINE NGUYEN  
PATENT EXAMINER**

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